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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,355	01/24/2002	Bruce Bradshaw	P05141US0	8052

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MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

15

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,355

Applicant(s)

BRADSHAW, BRUCE

Examiner

Tri M. Mai

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-12, 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Phillippi (4213614). Phillippi teaches a cover with a protective cover having an upper portion having a toe end and a heel end for enclosing the club head, and a clip 15 for securing the cover to the golf club.
2. Claim 11, 12, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sander (5547193). Sander teaches a cover with a protective pocket for fully protecting the head of the club, the lower portion with a clip as claimed. It is noted that the terms "heel" and "toe" end are broad. The cover in Sander has a plurality of ends that can be called as such. These terms do not impart any structure over the cover in Sander.
3. Claim 11, 12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by 11, 12, 15.

Claim Rejections - 35 USC § 103

4. Claims 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Gaffney (4898222) or Suggs (6321805) in view of Sander (5547193). Gaffney teaches a cover with a protective pocket adapted for fitting over the head of the golf club for fully protecting the head of the golf club, the cover having a toe end and a heel end and a partially open collar adjacent to and integral with the protective pocket. Suggs meets all claimed limitations except for a resilient clip. Sander teaches that it is known in the art to provide a clip. It would have been obvious for one of ordinary skill in the art to provide the clip in Gaffney as taught by Sander to provide an alternative means to secure the golf club.

Suggs teaches a cover with a protective pocket adapted for fitting over the head of the golf club for fully protecting the head of the golf club, the cover having a toe end and a heel end a partially open collar adjacent to and integral with the protective pocket. Suggs meets all claimed limitations except for a resilient clip. Sander teaches that it is known in the art provide a clip. It would have been obvious for one of ordinary skill in the art to provide the clip in Suggs as taught by Sander to provide an alternative means to secure the golf club.

5. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Gaffney or Suggs rejection, as set forth in paragraph 4 above, and further in view of Banas (3072167). Banas teaches that it is known in the art provide tabs including one at the heel area. It would have been obvious for one of ordinary skill in the art to provide the additional pull tabs in either Suggs or Gaffney as taught by Banas to handle the cover easily.

Regarding claim 7, it would have been obvious for one of ordinary skill in the art to make the clip out of metal to provide added durability and/or for added strength.

Regarding claim 8, note the liner 18 in Suggs, and a liner in Gaffney.

Response to Arguments

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide the clip of Sander in either Gaffney or Suggs would have been obvious

since all of these reference deal with means for securing the club with the cover and providing an equivalent is clearly within the skill of one of ordinary in the art.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
Art Unit 3727

